

REMARKS

IN THE CLAIMS

Applicants have canceled claims 1–19 and 29–32 without prejudice. Claims 1–19 are included in Groups I and III of the Examiner’s May 14, 2001 Restriction Requirement. Applicants reserve their right to pursue the restricted and canceled subject matter in any applications that claim priority herefrom.

Applicants have amended claim 21 to more particularly define the present invention (by reciting “1” rather than “0”). Support for the amendments is found, *e.g.*, on page 37, line 33 to page 38, line 6; page 37, lines 16–18; and in Examples 3B–D on page 50, line 21 to page 51, line 19 of the specification.

Applicants have amended claim 28 to place it in dependent form, depending from claims 20–25. Accordingly, applicants have canceled claims 29–32, the subject matter of which is captured in claims 22–25.

Applicants have amended claim 43 to delete reference to an autoimmune disease. Applicants have added claims 50–53 directed to a method for treating arthritis. Support for the amendment is found, *e.g.*, on page 10, line 6 of the specification.

None of the amendments adds new matter. Their entry is requested.

THE OFFICE ACTION

Applicants appreciate the Examiner’s withdrawal of the previous claim rejections under 35 U.S.C. § 112, first paragraph and second paragraph, in view of applicants’ January 24, 2002 amendments and remarks contained therein.

Applicants also appreciate the Examiner's withdrawal of the double patenting rejection under 35 U.S.C. § 101 and the claim rejections under 35 U.S.C. § 102(b) in view of applicants' said amendments and remarks.

The Information Disclosure Statement

The Examiner has stated that applicants' Information Disclosure Statement received on July 26, 2002 has been considered only in part. The Examiner has requested that applicants indicate which parent applications the remaining references are located, or to resubmit the references.

For the convenience of the Examiner, applicants have resubmitted the remaining references.

Nonstatutory Double Patenting Rejection

The Examiner has rejected claims 20–25, 28–32, 35–38, and 41–46 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1–30 of U.S. Patent 6,136,787 (hereinafter "the '787 patent"). The Examiner contends that the claims, while not identical, are not patentably distinct because the claims of the instant application are broader and embrace the more limited compound claims of the '787 patent. The Examiner indicates that a timely filed terminal disclaimer compliant with 37 C.F.R. § 1.321(c) may be used to overcome an obviousness-type double patenting rejection, provided that the conflicting patent is shown to be commonly owned with this application.

In accordance with the Examiner's suggestion, applicants have filed concurrently herewith a terminal disclaimer disclaiming the terminal portion of any patent granted on the instant application extending beyond the expiration date of the '787 patent.

§ 112, First Paragraph Rejection

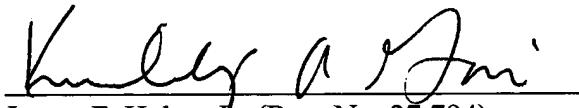
The Examiner has rejected claims 43–46 under 35 U.S.C. § 112, first paragraph, alleging that the specification does not enable one skilled in the art to make and/or use the invention. The Examiner contends that the specification does not provide guidance for the treatment of autoimmune diseases that may encompass many disorders. The Examiner states that the specification does not set forth a representative number of examples of claimed compounds that have immunosuppressive activity and that would be capable of treating various autoimmune disorders. The Examiner concludes that the quantity of experimentation necessary to practice the claimed inventions is undue. Applicants traverse.

To advance prosecution, however, applicants have amended claim 43 to delete “an autoimmune disease”, which the Examiner contends is not enabled. Applicants believe that the Examiner will find amended claim 43 and claims 44–46 that depend therefrom, drawn to methods for treating inflammatory conditions, fully enabled. Accordingly, applicants request that the Examiner withdraw the rejections under 35 U.S.C. § 112, first paragraph, of claims 43–46.

CONCLUSION

Applicants request that the Examiner enter the above amendments, consider the remarks and allow pending claims 20–25, 28, 35–38, 41–46 and 50–53. To expedite prosecution, the Examiner is invited to telephone the undersigned to discuss any matter that may be resolved over the telephone.

Respectfully submitted,



James F. Haley, Jr. (Reg. No. 27,794)
Attorney for Applicants
Min Wang (Reg. No. 51,303)
Kimberley A. Gavin (Reg. No. 51, 723)
Agents for Applicants
c/o FISH & NEAVE
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020
Tel.: (212) 596-9000
Fax.: (212) 596-9090